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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/786,181 | 02/25/2004 | Harry Bennett | BEN-1203 | 2383 |
| 7590 | 08/03/2005 | | EXAMINER | |
| Carl D. Crowell P.O. Box 923 Salem, OR 97308 | | | | CHIN, RANDALL E |
| | | ART UNIT | PAPER NUMBER | 1744 |

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/786,181 | BENNETT, HARRY |
| | Examiner Randall Chin | Art Unit 1744 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 7-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Upon further consideration, the following art rejections have been made. Any inconvenience is sincerely regretted.

Specification

2. The disclosure is objected to because of the following informalities:
On p. 4, line 6, the phrase "is not in used" is awkwardly written.
Also, On p. 4, line 19, the recitation "tool 100 is shown bent 202" is awkwardly written and it is suggested to change this phrase to –Tool 100 is shown to include a bend 202--. This would be **consistent** with line 20 which refers to "bend 202".
Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schofiled 153,119 (hereinafter Schofield '119)

Schofield '119 discloses a tool in Figs. 1-4 comprising a selected blade B (Fig. 2) and at least one remaining blade (d or e as **alternative** tools/blades as recited in paragraph 2 of Schofield '119) pivotally attached at a first end, said selected blade and each of said at least one remaining blade having a distinct blade width (as can be seen

Art Unit: 1744

in Fig. 5) wherein said selected blade is pivoted approximately 180 degrees away (Fig. 3) from said at least one remaining blade thereby allowing said at least one remaining blade to be used as a handle (Fig. 3) at said first end while said selected blade can be utilized (and is **capable of** such intended function) for striking a masonry joint with a second end opposite said first end of said at least one remaining blades.

As for the recitations "masonry tuck point tool" and "tuck" blade(s) in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As for claim 5, the blades have distinct blade lengths (Fig. 5).

As for claim 10, the blades have similar lengths (see the two blades d, e in Fig. 5 which are of similar length).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schofield '119.

As for claims 2 and 3 reciting that the tuck blades are made from rigid spring steel or hard plastic, respectively, such materials have distinct material properties and one skilled in the art would find it obvious to utilize such materials depending on material costs and ease of fabrication concerns. There is, of course, no reason why either material cannot be used since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

As for claims 4 and 7 (and 11) reciting that the blades are bent at an approximately 35 degrees or at an angle of between approximately 20 and 35 degrees, respectively, across the blade width between the first and second end (if not already as shown in Fig. 5), such choice of angle is well within the capabilities of one skilled in the art in order to optimally clean boots or hoofs (fourth paragraph of Schofield '119) and since such recited angle(s) appears very close (Fig. 5) to the angle(s) claimed.

As for the recitations "masonry tuck point tool" and "tuck" blade(s) in claim 11, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schofield '19 in view of Jones 544,540 (hereinafter Jones '540).

Schofield '119 discloses all of the recited subject matter with the exception of the angle being approximately equidistant between the first and second ends. The patent to Jones '540 teaches a blade A wherein the angle is located approximately equidistant between first and second ends. Note, both Schofield and Jones disclose horse/hoof tools and it would have been obvious to one of ordinary skill in the art to have modified Schofield's blades such that the angle is located approximately equidistant between first and second ends as taught by Jones '540 depending on hoof size and particular arrangement of the tool itself.

Conclusion

8. Applicant's arguments with respect to claims 1-5 and 7-11 have been considered but are moot in view of the new ground(s) of rejection.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Davis, Schenck, McCarter, Thienemann, Zion and Bauer are relevant to tool holders with pivotal arrangements.

Art Unit: 1744

10. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, John Kim, can be reached at (571) 272-1142. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Chin



Randall Chin
Primary Examiner
Art Unit 1744